

AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. APPLN. NO. 09/354,161
ATTORNEY DOCKET NO. Q55099

REMARKS

Applicant requests that the Examiner acknowledge Applicant's claim to foreign priority, and to indicate that the certified copy of the priority document, European Patent Application No. 99401613.7 dated June 28, 1999, has been made of record in the file.

Applicant thanks the Examiner for initialing the references listed on the PTO-1449 form submitted with the Information Disclosure Statement filed on February 18, 2000, thereby confirming that the listed references have been considered.

Applicant requests that the Examiner consider the references listed on the PTO-1449 form submitted with the Information Disclosure Statement filed on July 16, 1999 and returned an initialed PTO-1449 form in the next Communication, thereby confirming that the listed references have been considered.

Applicant herein amends the Title of the Invention for purposes of clarification and simplification. Entry of the amended Title is respectfully requested.

Applicant herein amends the written disclosure to correct typographical errors and to place the written disclosure in conformance with U.S. practice. No new matter has been added. Entry of the amendments to the written disclosure is respectfully requested.

Applicant herein amends the Abstract of the Disclosure. Due to the extensive nature of the amendments, a clean copy of the Abstract is provided. No new matter has been added. Entry of the new Abstract is respectfully requested.

Claims 1-11 have been examined on their merits.

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The Examiner objects to claims 4-6 as being dependent upon a rejected base claim.

Applicant thanks the Examiner for indicating that claims 4-6 would be allowed if rewritten in independent form. Applicant has rewritten claims 4 and 6 in independent form, and submits that these claims are allowable.

Applicant herein amends claims 2-11 to remove reference callouts and to place the claims in conformance with U.S. practice. The amendments to claims 2-11 were made merely to more accurately claim the present invention and do not narrow the literal scope of the claims and thus do not implicate an estoppel in the application of the doctrine of equivalents. The amendments to claims 2-11 were not made for reasons of patentability.

Applicant herein adds new claims 12-14. Support for new claims 12-14 can be found in original claims 4-6. Entry and consideration of the new claims 4-6 is respectfully requested.

Claims 1-14 are all the claims presently pending in the application.

1. Claims 1-3 and 7-11 stand rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by Apperson *et al.* (U.S. Patent No. 5,978,484). Applicant traverses the rejection of claims 1-3 and 7-11, and insofar as the rejection applies to new claims 12-14, for at least the reasons discussed below.

To support a conclusion that a claimed invention lacks novelty under 35 U.S.C. § 102, a single source must teach all of the elements of a claim. *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1379 (Fed. Cir. 1986). A claim is anticipated only if each and every element as set forth in the claim is found either expressly or inherently in a single prior art

reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987).

A single source must disclose all of the claimed elements arranged as in the claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989). Rejections under 35 U.S.C. § 102 are proper only when the claimed subject matter is identically disclosed or described in the prior art. Thus, the cited reference must clearly and unequivocally disclose every element and limitation of the claimed invention.

Apperson et al. fail to teach or suggest a service provider forwarding a request to a certifying authority for authorization, wherein the request comprises a definition of at least part of a global functionality supported in a telecommunication environment, and further, including in the certificate a definition of the predefined functionality if the request is granted by the certifying authority, as recited in claim 1. The Examiner asserts that hierarchical tree shown in Figure 3 of *Apperson et al.* somehow discloses a service provider making a functionality request to a certifying authority. However, in *Apperson et al.*, all the privilege request codes are already incorporated into the certificates, and there is no disclosure of examination of individual functionality requests from service providers.

Based on the foregoing reasons, Applicant submits that *Apperson et al.* fail to disclose all of the claimed elements as arranged in claim 1. Therefore, under *Hybritech* and *Richardson*, *Apperson et al.* clearly cannot anticipate the present invention as recited in independent claim 1. Thus, Applicant submits that claim 1 is allowable, and further submits that claims 2, 3, 7-11 and new claims 12-14 are allowable as well, at least by virtue of their dependency from claim 1.


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Applicant respectfully requests that the Examiner withdraw the § 102(e) rejection of claims 1-3 and 7-11.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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CUSTOMER NUMBER

Date: February 17, 2004

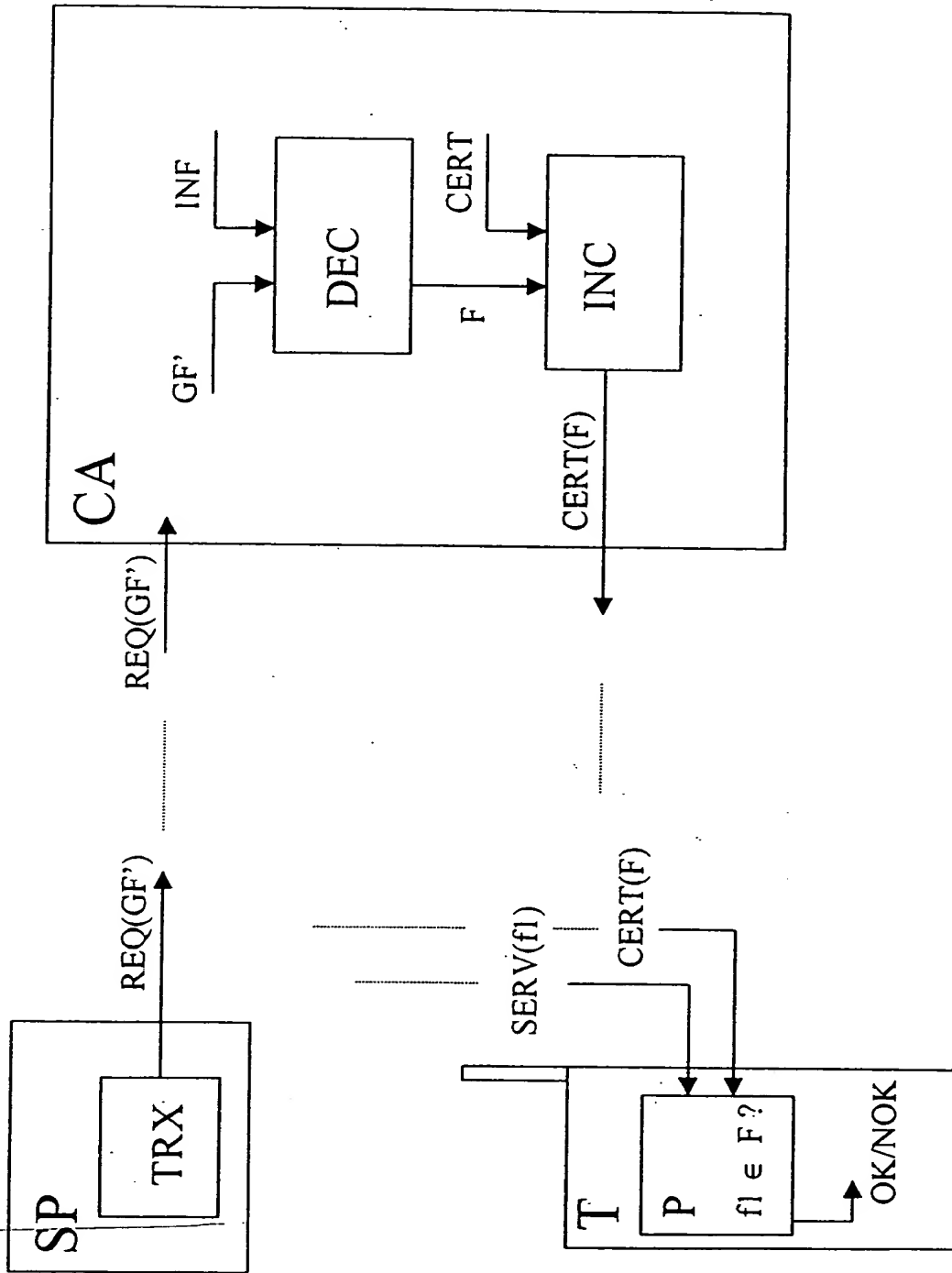
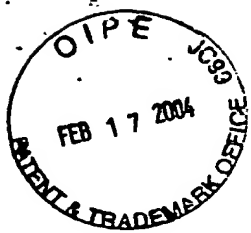


Figure Fig. 1